Appl. No. 09/870,538
Appeal Brief dated February 23, 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.   : 09/870,538   Confirmation No.: 1320
Applicant(s): James K. Prueitt et al.
Filed   : May 30, 2001
Title   : METHOD AND SYSTEM FOR GENERATING
               : A PERMANENT RECORD OF A SERVICE
               : PROVIDED TO A MOBILE DEVICE
TC/A.U.   : 2143
Examiner   : Joseph E. Avellino

Docket No.   : 8505
Customer No.: 20349

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P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

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Sir:

This is appellants' Appeal brief in the appeal
taken from the final rejection of claims 1 - 5, 7 - 9,
11 - 15, 17 - 20, 22 - 28 and 30 of the application as
set forth in the Office Action, made final, mailed
July 25, 2005. A two (2) month extension of the time
period to file the Appeal Brief has been obtained by a
Petition filed on even date herewith.

REAL PARTY IN INTEREST

The real party in interest in this appeal is
Polaroid Corporation, a corporation organized and
existing under the laws of the State of Delaware, of
1265 Main Street, Waltham, MA 02451.

RELATED APPEALS AND INTERFERENCES

There are no related appeals and
interferences.

STATUS OF CLAIMS

1.   Claims 1 - 5, 7 - 9, 11 - 15, 17 - 20, 22
- 24 and 30 have been rejected as being unpatentable
over the references applied in support of the
rejections.

2. Claims 38 – 39 have been withdrawn from consideration pursuant to a requirement for Restriction.

STATUS OF AMENDMENTS

Appellants did not file an amendment after the final Office action and elect to prosecute this appeal on the basis of the claims which were in the application prior to the final Office Action.

SUMMARY OF INVENTION

Appellants' claims are directed to a method and system for providing users of mobile digital devices the opportunity to obtain a permanent record of a service originating at the mobile device and not related to the location of the device. The method provides a service at a mobile device and generates, at the location of the mobile device, a permanent record of the service, the service and the permanent record being processed by at least one of many remote servers.

The method comprises the steps of (a) receiving at a receiving center, from the mobile device, a request for the service, (b) providing, from the receiving center, data for the request to a service server, the service server being one of the at least one

of many remote servers, (c) processing the request for service at the service server, the processing generating the data for the service, (d) providing the data for the service to a printing server, the printing server being one of the at least one of many remote servers, (e) processing, at the printing server, the data and other stored data to generate input data for a specific printer, (f) transmitting to the mobile device the input data, the input being rendered by the specific printer at the location of the mobile device as the permanent record of the service.

According to the method the data that will be sent to a specific printer is processed in a manner to produce the optimal quality print for the specific printer. The novel combination of elements defining the claimed method and system of the present invention not only print out a record of a service on a specific printer at the location of the mobile device but, in addition, <u>are configured to process the data to provide an optimal quality print for the specific printer</u>.

REFERENCES APPLIED AGAINST THE CLAIMS

1. International Patent Application Publication No. WO 01/03040 A1 ("Klear et al.").

2. U.S. Patent No. 6,553,240 B1 ("Dervarics").

3. United States Patent Application
Publication No. US 2002/0065873 ("Ishizuka").

4. U.S. Patent 6,725,051 B2 ("Fidler").

DISCUSSION OF THE REFERENCES

1. Klear et al. relates to recording service
or transaction data electronically on media such as
smart cards or the like and refers to printing a ticket
or a receipt.

2. Dervarics relates to a mobile device such
as a cell phone that is configured with WML web page
data and internal data such as calendar and phone book
information.

3. Ishizuka relates to a method for printing
from a wireless mobile device over a computer network,
including transmitting to a wide area network
information a user wishes to print using a wireless
mobile device.

4. Fidler relates to a method for obtaining
location data for use by a peripheral device including
the steps of communicating with a second device via a
wireless protocol and querying the second device for
location data.

ISSUES

A. Whether the subject matter of claims 1 -
3, 5 - 7, 9, 11, 12, 17 - 20, 22 - 24 and 30 is

unpatentable under 35 USC § 103(a) over Klear et al. in view of Dervarics in view of Ishizuka.

B.   Whether the subject matter of claims 4, 13 - 15 and 25 - 28 is unpatentable under 35 USC § 103(a) over Klear et al. in view of Dervarics and Ishizuka and further in view of Fidler.

GROUPING OF CLAIMS

Pursuant to 37 CFR 1.192(c)(7), appellants request that the claims on appeal be considered as two separate groups as follows:

1.   Claims 1 - 3, 5 - 7, 9, 11, 12, 17 - 20, 22 - 24 and 30.

2.   Claims 4, 13 - 15 and 25 - 28.

ARGUMENT

Summary

There is no suggestion or incentive to be found in the references cited to support the obviousness rejections which would place one skilled in the art in possession of the claimed subject matter as is required to properly support the rejections under 35 U.S.C. §103(a). The USPTO has not sustained the burden of showing that the claimed subject matter is unpatentable.

Issue (A).

Appellants' specification describes a method and system for providing users of mobile digital devices the opportunity to obtain a permanent record of a service originating at the mobile device and not related to the location of the device. The method provides a service at a mobile device and generates, at the location of the mobile device, a permanent record of the service, the service and the permanent record being processed by at least one of many remote servers.

According to the method the data that will be sent to a specific printer is processed in a manner to produce the optimal quality print for the specific printer. The novel combination of elements defining the claimed method and system of the present invention not only print out a record of a service on a specific printer at the location of the mobile device but, in addition, are configured to process the data to provide an optimal quality print for the specific printer.

The method of appellants recited in claim 1 requires the step of

> (E) processing, at the printing server, said service data and stored print data for the identified specific printer to generate input data for the specific printer in a manner to produce the optimal quality print for the specific printer;

The other method claims included in this ground of rejection, namely 2, 3, 5 - 7, 9, 11 and 12 are

dependent upon claim 1 either directly or indirectly and thus include the limitation of producing the optimal quality print for a specific printer.

The system claims include the same limitation. Independent claim 18 requires

> (E) means for processing, at the printing server, said service data and stored print data for the identified specific printer to generate input data for a the specific printer in a manner to produce the optimal quality print for the specific printer

The other system claims included in this ground of rejection, namely 19, 20, 22 - 24 and 30 are dependent upon claim 18 either directly or indirectly and thus include the same limitation.

At page 11, lines 11 - 24 of the present Specification, appellants have described in detail techniques for producing an image of optimal quality at the specific printer. These techniques include image processing described and claimed in U.S. Patents 5,684,484, 6,128,415 and 6,937,365. Thus, producing optimal quality print for a specific printer in accordance with the method and system of appellants involves image processing.

In support of the rejection the Office Action, at the last full paragraph of page 2, states that

> "...Klear discloses a method for providing a service (i.e. purchasing tickets to a movie) at a device and generating , at the location of said device a permanent record (i.e. bar

coded receipt) of said service, said service
and said permanent being process by at least
one of a plurality of remote servers (Fig. 5
ref. 26)

Klear et al. is primarily directed to
recording service or transaction data electronically on
media such as smart cards and the like and makes mention
of printing a ticket or a receipt (see, for example,
page 10, lines 28 - 32). However, Klear et al. does not
specifically disclose or in any way suggest that the
print data be processed in a manner to produce the
optimal quality print for the specific printer, as is
required by the claims of appellants.

The Office Action acknowledges that Klear et
al. does not teach or suggest critical features of
appellants' claimed subject matter. The Office Action,
at page 3 states

Klear does not disclose that the device is a
mobile device and that the input data
transmitted to the mobile device is rendered
by the specific printer at the location of the
mobile device.

Accordingly, there is no dispute over the fact that the
primary reference does not teach or suggest critical
features of appellants' claimed subject matter.

The Office Action goes on to assert, at page
3, that

> In analogous art, Devarics discloses another
> method to print information from the Internet
> which allows input data transmitted to the
> mobile device (i.e. WAP device 100) to be
> rendered by a specific printer 120 at the
> location of the mobile device.

However, Dervarics, like Klear et al., does not disclose
or suggest critical features of appellants' claimed
subject matter.

Dervarics discloses, in Fig. 1, a WAP
(Wireless Application Protocol) mobile device (such as
cell phone 100) that is configured WML (Wireless Markup
Language) web page data and internal data such as
calendar and phone book information. In Fig. 3 and
beginning at column 6, line 45 and continuing onto
column 7, Dervarics discloses the phone has a print
facility integrated into the source code of the
operating system software for the cell phone. The
printing facility is shown in block diagram form in Fig.
3.

At column 7, starting at line 12, Dervarics
states that

> A printing module 304 contains a printer
> buffer 304-1 and printing routines 304-2. The
> printing routines 304-2 are preferably part of
> the browser, but utilize the appropriate
> application programming interface (API) of the
> operating system software to implement the
> printing facility of the mobile phone.

At column 7, beginning at line 23, it is disclosed that

> ...the character width of the display 207 controlled by the display module 303 is typically much narrower than the character width of the printing facility controller by printing module 304. WML decoder 301 makes the necessary conversions and wrap-arounds so that the decoded WML data displayed on display 207 can be suitably printed.

It is clear that Dervarics discloses the use of software, within the cell phone, to convert the narrowly formatted WML data for the display to a wider width that is compatible with an identified local printer at the location of the cell phone.

However, Dervarics, like Klear et al., does not disclose, teach or suggest the methods and systems set forth in the present claims wherein information identifying a specific local printer is sent to the remote servers at the service provider via the mobile device; a remote printing server has stored print data for optimizing the quality of print printed on a specific printer; and the printing server processes service data and stored print data for the identified specific printer in a manner to produce the optimal quality print for the specific printer. To the contrary, Dervarics focuses on WAP capable mobile devices and at column 3, starting at line 45 states

> The WAP device 100 differs from the personal computer with internet browser 139 in that it

generally has a less powerful CPU, less
memory, restricted power consumption, smaller
displays and more limited network devices.

Because Dervarics performs print data
processing locally in the limited resource cell phone it
is clear that the phone does not have the capacity to do
the type of print optimization process taught by
appellants in the present application. Dervarics does
not disclose, teach or suggest the concept of doing
computer intensive print optimization processing on high
capacity remote servers operated by the service
provider.

The Office Action acknowledges that Dervarics,
in combination with Klear et al., does not teach or
suggest critical features of appellants' claimed subject
matter. The Office Action, at page 4 states

Klear in view of Devarics does not
specifically disclose receiving information
identifying a specific printer on which to
print the permanent record, and the printing
server including stored print data for
optimizing the quality of prints printed on
various specific printers.

Accordingly, there is no dispute over the fact that the
combined disclosures of Klear et al. and Dervarics do
not teach or suggest critical features of appellants'
claimed subject matter.

The Office Action relies on Ishizuka to
provide the teaching which is missing from Klear et al.

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and Dervarics. At page 4 of the Office Action it is stated that

> In analogous art, Ishizuka discloses another method to print information off the Internet which includes receiving information identifying a specific printer on which to print the permanent record (e.g. abstract "printer selected by the user" p. 5 ¶ 48) as well as the printing server including stored print data for optimizing the quality of prints (i.e. printer drivers for interfacing the software with the printer, this is considered "print data for optimizing the quality of prints" since the driver allows the print data to be formatted appropriately for the type and size of printer) printed on various specific printers (Figure 4, ref 413; Figure 6, ref 607; p. 5, ¶ 49).

The Office Action concludes that

> It would have been obvious to one of ordinary skill in the art to combine the teaching of Ishizuka with Klear and Devarics in order to provide the user the ability to print to a printer which is not earlier known to the user such that the server has the ability to adapt to the user allowing greater flexibility and increasing the user's ability to utilize the system.

This conclusion is based on an erroneous interpretation of the teaching of Ishizuka in relation to the presently claimed subject matter. Ishizuka does not teach or suggest producing "optimal quality print for the specific printer" within the meaning of that language as used in the present claims.

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As pointed out previously, at page 11, lines 11 - 24 of the present specification appellants have described in detail techniques for producing an image of optimal quality at a specific printer. These techniques include image processing described and claimed in U.S. Patents 5,684,484, 6,128,415 and 6,937,365. Thus, producing optimal quality print for a specific printer in accordance with the method and system of appellants involves image processing and not merely formatting print data appropriately for a specific printer as is accomplished by a printer driver.

Ishizuka, like Klear et al. and Dervarics, is completely silent with respect to this critical feature of appellants' claimed method and system. Ishizuka, at best, (and as referred to in the Office Action) teaches only the use of a printer driver to format print data for a specific printer.

In order to properly support a rejection under Section 103 the reference or references relied upon to support the rejection must place the claimed subject matter in the possession of the general public. The reference(s) must provide some teaching or suggestion which would enable those skilled in the art, in conjunction with their knowledge of the state of the art, to know of the claimed invention. It has been shown that the references do not teach or in any way suggest a critical feature of appellants' claimed method and system. Here, only the disclosure of appellants'

specification is sufficient to make the claimed subject matter known to the public.

Further, the only way that the cited references could be said to teach appellants' claimed subject matter would be to take from each of them, in light of appellants' specification, only so much of their respective disclosures as would support the rejection. Such hindsight reconstruction of the prior art is not permissible within the meaning of Section 103.

For all the foregoing reasons, the combination of Klear et al., Dervarics and Ishizuka does not support the rejection of claims 1 - 3, 5 - 7, 9, 11, 12, 17 - 20, 22 - 24 and 30 under 35 U.S.C. §103(a) and the USPTO has failed to sustain the burden of showing that the claimed subject matter is unpatentable.

Issue (B).

Claims 4, 6 (now canceled), 13 - 15 and 25 - 28 have been rejected as being unpatentable under 35 USC § 103(a) over Klear et al. in view of Dervarics and Ishizuka and further in view of Fidler.

Claims 4 and 13 - 15 are dependent upon claim 2, directly or indirectly. Claim 25 is dependent upon claim 24 and claims 25 - 28 are dependent upon claim 24.

These claims are patentably distinguishable for the same reasons discussed above with respect to

Klear et al. Dervarics and Ishizuka and further because
Fidler does not teach or suggest critical features of
appellants' claimed subject matter including producing
the optimal quality print for a specific printer in
accordance with the invention of appellants.

The embodiment of appellants' invention
recited in these claims extends the capability of their
method and system to encompass location based services.
Such location based services require the selected
service provider to obtain the geographic location of
the mobile device carried by a user. Once located the
service provider can provide local information such as
the names, locations and menus for restaurants close to
the user or the location of movie theaters in the
vicinity of the user.

This group of claims has, in addition to the
optimal quality print limitation, a commonality in that
they include limitations that are directed to the
location-based service aspects of the invention.

Fidler is directed to a method for obtaining
location data for use by a peripheral device. As set
forth at column 2 beginning at line 50, the method is
described as including the steps of communicating with a
second device via a wireless protocol and querying the
second device for location data. To one having ordinary
skill in the art, Fidler would appear to be, at best, a
diagnostic tool for a network administrator.

In contrast, these embodiments of the
invention of appellants are directed to an interactive
service in which a user requests a location based
service (nearby restaurants etc,) from a service
provider which needs the location of the mobile device
to provide the user with appropriate location based
service.

The method of Fidler does not teach or even
remotely suggest providing the interactive dialog
between a user and service provider to obtain a location
based service for the user and also to allow the user to
make an optimal quality printed record of the service at
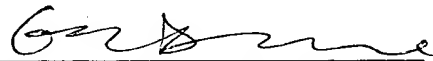the location of the mobile device.

For all the foregoing reasons, the combination
of Klear et al., Dervarics, Ishizuka and Fidler does not
support the rejection of claims 4, 13 – 15 and 25 – 28
under 35 U.S.C. §103(a) and the USPTO has failed to
sustain the burden of showing that the claimed subject
matter is unpatentable.

CONCLUSION

For all of the foregoing reasons the 35 USC §103(a) rejections should be reversed and claims 1 - 5, 7 - 9, 11 - 15, 17 - 20, 22 - 28 and 30 allowed.

Respectfully submitted,

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CLAIMS APPENDIX

<u>Claims On Appeal</u>

1. A method of providing a service at a mobile device and generating, at the location of said mobile device, a permanent record of said service, said service and said permanent record being processed by at least one of a plurality of remote servers, said method comprising the steps of:

   (A) receiving at a receiving center, from the mobile device, a request for the service and information identifying a specific printer on which service related data is to be printed at the location of the mobile device;

   (B) providing, from the receiving center, data for the request to a service server, said service server being one of said at least one of a plurality of remote servers;

   (C) processing the request for service at the service server, said processing generating the data for the service;

(D) providing said data for the service to a printing server, said printing server being one of said at least one of a plurality of remote servers and including stored print data for optimizing the quality of prints printed on various specific printers;

(E) processing, at the printing server, said service data and stored print data for the identified specific printer to generate input data for the specific printer in a manner to produce the optimal quality print for the specific printer;

(F) transmitting to said mobile device said input data, said input being rendered by the specific printer at the location of said mobile device as the permanent record of said service.

2. The method of Claim 1 wherein the receiving center is a receiving server, said receiving server being one of said at least one of a plurality of remote servers.

3. The method of Claim 1 wherein step (C) further comprises:

completing a transaction at a transaction server, said transaction depending on the requested service, said transaction server being one of said at least one of a plurality of remote servers.

4. The method of Claim 2 further comprising the step of:

receiving at the receiving server, prior to step (C), data on the location of the mobile device, said data being generated by means for determining the location of the device.

5. The method of Claim 1 further comprising the step of:

sending, after step (C), to the mobile device, a message confirming that the request for service has been fulfilled.

7. The method of Claim 2 wherein the receiving server is the service server.

8. The method of Claim 4 wherein the receiving server is the service server.

9.   The method of Claim 2 wherein the receiving server is the printing server.

11.   The method of Claim 1 wherein the requested service is an event ticket.

12.   The method of Claim 1 wherein the requested service is a coupon.

13.   The method of Claim 4 wherein the requested service is a location based service.

14.   The method of Claim 4 wherein said means for determining the location of a device comprise a device based method.

15.   The method of Claim 4 wherein said means for determining the location of a device comprise a network based method.

17.   The method of Claim 1 wherein the receiving center is a service center.

18.   A system of providing a service at a mobile device and generating, at the location of said mobile device, a permanent record of said service, said service and said permanent record being processed by at least

one of a plurality of remote servers, said system comprising:

means for receiving at a receiving center, from the mobile device, a request for the service and information identifying a specific printer on which service related data is to be printed at the location of the mobile device; and

means for providing, from the receiving center, data for the request to a service server, said service server being one of said at least one of a plurality of remote servers; and

means for processing the request for service at the service server, said processing generating the data for the service; and

means for providing said data for the service to a printing server, said printing server being one of said at least one of a plurality of remote servers and including stored print data for optimizing the quality of prints printed on various specific printers;

means for processing, at the printing server, said service data and stored print data for the identified specific printer to generate input data for a the specific printer in a manner to produce the optimal quality print for the specific printer ; and

means for transmitting to said mobile device said input data, said input being rendered by the specific printer at the location of said mobile device as the permanent record of said service.

19. The system of Claim 18 further comprising:

means for completing a transaction at a transaction server, said transaction depending on the requested service, said transaction server being one of said at least one of a plurality of remote servers.

20. The system of Claim 18 further comprising:

means for sending to the mobile device a message confirming that the request for service has been fulfilled.

22.   The system of Claim 18 wherein the requested service is an event ticket.

23.   The system of Claim 18 wherein the requested service is a coupon.

24.   The method of Claim 18 wherein the receiving center is a receiving server, said receiving server being one of said at least one of a plurality of remote servers.

25.   The system of Claim 24 further comprising:

means for receiving, at the receiving server, data on the location of the mobile device, said data being generated by means for determining the location of a device.

26.   The system of Claim 25 wherein the requested service is a location based service.

27.   The system of Claim 25 wherein said means for determining the location of a device comprise a device based system.

28.   The system of Claim 25 wherein said means for determining the location of a device comprise a network based system.

30.   The system of Claim 18 wherein the receiving center is a service center.

EVIDENCE APPENDIX

Appellants have not submitted in the application any evidence pursuant to §§ 1.130, 1.131 and 1.132 of 37 Code of Federal regulations.

RELATED PROCEEDINGS APPENDIX

There are no decisions by a court or the Board of Patent Appeals and Interferences in any related proceedings.

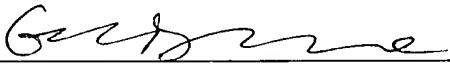## CERTIFICATE OF MAILING

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Date: February 23, 2006

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